

REMARKS

This amendment responds to the Advisory Action dated March 4, 2004, and the Office Action dated June 17, 2003. The amendment is similar to the non-entered amendment filed on February 17, 2004, however, claim 11 has been amended in accordance with the advisory action to no longer to depend upon cancelled claim 25.

In the Advisory Action the Examiner states that the amendment filed on February 17, 2004, would not overcome “the objection of claims 11-14 based upon multiple dependency.” Claims 11-14 are not multiple dependent claims that depend from other multiple dependent claims. Accordingly, this rejection should be withdrawn.

The disclosure has been objected to because incorrect symbols appear in the substitute specification. A second substitute specification has been included with this amendment to correct these errors and various other typographical errors. No new matter has been added.

Claims 11-14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. Multiple dependent claim 11 has been amended to no longer depend from multiple dependent claim 10. Consequently, none of claims 11-14 are now multiple dependent claims which depend from another multiple dependent claim. Accordingly, this objection should be withdrawn.

Claim 9 is objected to because the number “4” appears between the word primer and SEQ ID NO:4. In accordance with the Examiner’s suggestion, the number “4” has been removed from this claim.

Claims 1 and 19 stand rejected under 35 USC 102(b) as being anticipated by Goodman. This rejection is respectfully traversed.

Claim 1 has been amended to specify that the isolated nucleic acid molecule comprises a sequence of nucleotides “as set forth in SEQ ID NO:3, a nucleotide sequence having at least 70% identity to SEQ ID NO:3 or a nucleotide sequence capable of hybridizing to SEQ ID NO:3 under

stringency conditions of hybridization and washing in 2 X SSC, 0.1% w/v SDS at 45°C.” An amino nucleotide sequence having at least 70% identity is disclosed on page 13, line 2, of the specification as filed. The claimed stringency conditions are disclosed on page 14 of the specification as filed. No new matter has been added.

Goodman fails to disclose or suggest the nucleotide sequence from the promoter defined by SEQ ID NO:3, a nucleotide sequence with 70% identity to SEQ ID NO:3 or a nucleotide sequence capable of hybridizing to SEQ ID NO:3 under the claimed conditions. Accordingly, this rejection should be withdrawn.

Claims 5, 10, 15 and 25 stand rejected under 35 USC 112, second paragraph as being indefinite. Claims 5, 10 and 25 have been cancelled. Accordingly, the rejection of these claims is now moot.

Claim 15 stands rejected under 35 USC 112, second paragraph, because the Examiner “is unclear how closely related the derived sequences are to the original sequences and it is also unclear what procedures were used to derive the claimed sequences.” This rejection is respectfully traversed.

Claim 15 claims a modular promoter that includes at least one portion which is derived from a promoter as set forth in SEQ ID NO:3 or a nucleotide sequence capable of hybridizing to SEQ ID NO:3. Accordingly, claim 15 claims a modular promoter with any degree of derivation from the specified promoter. The claimed modular promoters can be derived from the specified promoter by any known method.

Claims 1, 5, 7, 9-10, 15 and 19-25 stand rejected under 35 USC 112, first paragraph. The claims as amended overcome these rejections. The Examiner states that the written description requirement for genus claims may be satisfied through “disclosure of relevant identifying characteristics, i.e. structure or other physical and/or chemical properties, by functional characteristics coupled with known or disclosed correlations between function and structure, or by a

combination of such characteristics sufficient to show that the applicant was in possession of the claimed genus."

Claims 1 and 7 have been amended to specify that the nucleotide sequence is "as set forth in SEQ ID NO:3, a nucleotide sequence having at least 70% identity to SEQ ID NO:3 or a nucleotide sequence capable of hybridizing to SEQ ID NO:3 under stringency conditions of hybridization and washing in 2 X SSC, 0.1% w/v SDS at 45°C." These claimed structural features in combination with the previously claimed characteristics would be sufficient to show one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed genus.

In addition, the Examiner states that the previously claimed low stringency conditions (6X SSC, 0.1% w/v SDS at 42°C) were insufficient to show relationship between the structure of the sequence and its function. Claims 1, 7 and 15, which contain hybridization conditions, have been amended to claim medium stringency conditions as specified on page 14 of the original specification. Applicants submit that under these conditions, the diversity of the sequences identified would not be so great as to require undue experimentation to determine the promoter activity thereof.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

For the foregoing reasons a notice of allowance allowing claims 1, 7, 9 and 11-25 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost

of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 229752001300.

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Respectfully submitted,

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